



**UNITED STATES DEPARTMENT OF COMMERCE**  
**Patent and Trademark Office**

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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.
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09/361,425 07/27/99 KUNG

J JBP461

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HM22/0509

EXAMINER

ROBINSON, P

ART UNIT

PAPER NUMBER

1653

DATE MAILED:

05/09/00

**Please find below and/or attached an Office communication concerning this application or proceeding.**

**Commissioner of Patents and Trademarks**

# Office Action Summary

Application No.

09/361,425

Applicant(s)

KUNG ET AL.

Examiner

Patricia A. Robinson

Art Unit

1653

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136 (a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).

## Status

- 1) ☒ Responsive to communication(s) filed on 13 April 2000.
- 2a) ☒ This action is FINAL. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 1,2,5-13 and 15 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1,2,5-13 and 15 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claims \_\_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are objected to by the Examiner.
- 11) ☐ The proposed drawing correction filed on \_\_\_\_\_ is: a) ☐ approved b) ☐ disapproved.
- 12) ☐ The oath or declaration is objected to by the Examiner.

## Priority under 35 U.S.C. § 119

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).
- a) ☐ All b) ☐ Some \* c) ☐ None of the CERTIFIED copies of the priority documents have been:
1. ☐ received.
2. ☐ received in Application No. (Series Code / Serial Number) \_\_\_\_\_.
3. ☐ received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

- 14) ☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. & 119(e).

## Attachment(s)

- 14) ☒ Notice of References Cited (PTO-892)
- 15) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 16) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) \_\_\_\_\_.

- 17) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_\_.
- 18) ☐ Notice of Informal Patent Application (PTO-152)
- 19) ☐ Other: \_\_\_\_\_.

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### **DETAILED ACTION**

#### ***Election/Restrictions***

Applicant's election with traverse of Group I, claims 1-15 in Paper No. 5 is acknowledged. In addition, the election of oil-soluble, oxygen-labile species retinol and tocopherol and the water-soluble, oxygen-labile species ascorbic acid, where n-acetylcysteine acts as the stabilizer is noted.

The traversal is on the ground(s) that although the structures identified are different, they are similar in that they are both known as oil-soluble, oxygen-labile species and therefore searching all would not pose an additional burden on the Patent Office. This is not found persuasive because of the following reasons: (1) each species is structurally and functionally divergent and would require separate non-overlapping searches; and (2) each species is distinct in its chemical structure and can be utilized in divergent manners and thus a separate search would be required for each individual species, restriction for examination purposes as indicated is proper.

The requirement is still deemed proper and is therefore made FINAL.

#### ***Response to Arguments***

Silicones (as defined in the Oxford Dictionary of Biochemistry and Molecular Biology, 1997) are, depending on its molecular size and configuration and the nature of the R groups, may be oils, greases, gums, etc. (See attached). Thus the Robinson et

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al. (previously referenced as "Reed et al." in the Office Action dated 1/10/2000)  
reference encompasses water-in-oil retinol/-containing compositions.

Applicant's additional arguments with respect to claims 1,2,5-13 and 15 have been considered but are moot in view of the new ground(s) of rejection and Applicant's amendments to the claims.

#### ***Information Disclosure Statement***

The information disclosure statement filed 4/43/2000 fails to comply with 37 CFR 1.98(a)(1), which requires use of a Form PTO-1449 listing all patents, publications, or other information be submitted for consideration by the Office. It has been placed in the application file, but the information referred to therein has not been considered.

#### ***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation

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under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(f) or (g) prior art under 35 U.S.C. 103(a).

Claims 1,2,5-13 and 15 are rejected under 35 U.S.C. 103(a) as being unpatentable over Robinson et al. taken with Mason et al.

Robinson et al. (previously referenced "Reed et al." in the Office Action dated 1/10/2000) taken with Mason et al. which teaches the addition of water-soluble vitamins and derivatives and other anti-oxidants to further improve stability, utilize therapeutic qualities and generally optimize the usefulness of the composition as a whole. (See Col. 8 line 62- Col. 12, line 63). Thus, where Robinson et al. is silent about additional methods of increased stability and utility of the compositions it would have been obvious to one of ordinary skill in the art to have modified Robinson et al. by using the teachings of Mason et al., which references when combined teach all of claims 1,2,5-13 and 15. Therefore, the claimed invention was within the ordinary skill in the art to make and use at the time it was made and was as a whole, *prima facie* obvious.

Applicant's arguments filed 4/13/2000 have been fully considered but they are not persuasive.

Applicant's argue that the Robinson et al. (previously referenced "Reed et al. in the Office Action date 1/10/2000) reference does not teach the use of other oxygen-labile species or antioxidants to stabilize retinol containing compositions, nor does it

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teach the presence of N-acetyl cysteine in the compound as a stabilizer per se. In response to applicant's argument that N-acetyl cysteine is not identified as a stabilizer per se, the fact that applicant has recognized another advantage which would flow naturally from following the suggestion of the prior art cannot be the basis for patentability when the differences would otherwise be obvious. See *Ex parte Obiaya*, 227 USPQ 58, 60 (Bd. Pat. App. & Inter. 1985). Furthermore, the fact that it is well known in the art to use N-acetyl cysteine as a stabilizer can be witnessed in the current application. (See Specification, page 1, line 25 – page 2, line 10). Finally, Applicant's argument regarding Robinson et al. not teaching the use of other oxygen-labile species or antioxidants with retinol is overcome by the new rejection, and is therefore moot.

### ***Conclusion***

No claims are allowed.

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not

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mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Patricia A. Robinson whose telephone number is 703-305-0096. The examiner can normally be reached on 8:00 - 4:30 Monday - Friday, off alternate Fridays.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Christopher Low can be reached on 703-308-2923. The fax phone numbers for the organization where this application or proceeding is assigned are 703-308-4242 for regular communications and 703-305-3014 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-308-0196.

  
CHRISTOPHER S.F. LOW  
SUPERVISORY PATENT EXAMINER  
TECHNOLOGY CENTER 1600

PAR  
May 8, 2000